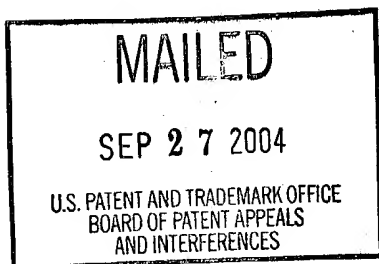


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GEORGE M. ALLEMAN JR., ROLAND ZEDER, and ALEX BALLY



Appeal No. 2004-1910
Application No. 09/411,106

ON BRIEF

Before GARRIS, WALTZ, and PAWLIKOWSKI, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the Examiner's rejections of claims 1-31, 48-50, 52-61, 71-75 and 82 which are said to be all of the claims remaining in the application.

Many aspects of these rejections lacked clarity due to the manner in which the Examiner and her Supervisory Patent Examiner (SPE) prepared the answer mailed June 4, 2002. As a consequence, the above identified application was remanded by this panel of the Board to the Examining Corps in order to clarify the application file record in numerous respects. In response, the application

Appeal No. 2004-1910
Application No. 09/411,106

has now been returned to the Board from the Examining Corps in a condition such that the Examiner and her SPE have clarified certain aspects of the record although unfortunately many other aspects remain unclear. For example, in the record now before us, the status of dependent claim 71 remains unclear (notwithstanding our identification of this problem in the first full paragraph on page 5 of our remand mailed Nov. 6, 2003) since this claim has been neither rejected nor indicated as being allowable by the Examiner and her SPE in the supplemental answer mailed January 30, 2004 (which is said to be "in response to the appeal brief filed 5/1/02 and the remand of 11/6/03" (answer, page 2)). Nevertheless, on page 3 of this answer, the Examiner and her SPE have expressly stated that "any grounds of rejection not included below has [sic] been withdrawn." As a consequence of this statement and because claim 71 is not included in any of the grounds of rejection set forth in this answer, we consider this claim to not be in a rejected status and therefore hereby dismiss the appeal with respect thereto.

Little useful purpose would be served by further expounding upon other aspects of this appeal record which lack clarity. This is because these other aspects are nullified by the aforequoted statement of the Examiner and her SPE and by our disposition of

Appeal No. 2004-1910
Application No. 09/411,106

the rejections now before us. Suffice it to say, therefore, that the Examiner and her SPE in effect have withdrawn all final rejections except their § 103 rejections of claims 1, 3, 5, 9, 13, 16, 19, 22, 24, 26, 29, 48-50, 52-55, 57-61 and 74 and their § 112, first paragraph, rejection of claims 48-50, 52-61, 73-75 and 82. These are all of the claims now remaining on this appeal.

The subject matter on appeal relates to a moveable undercarriage for supporting and moving a welder and/or power supply over a ground surface. With reference to the Appellants' drawing, the undercarriage 20 comprises a base 30, a front and rear axle 70, 80, front wheels 90, rear wheels 100 and a push bar 130 wherein the front and rear axles or axes are spaced apart along the longitudinal axis of the base at a distance less than about 3 times the sum of the radii of the front and rear wheels. This appealed subject matter is adequately illustrated by independent claim 48 which reads as follows:

48. A moveable undercarriage for supporting and moving welder or power supply over a ground surface comprising a base structure, at least one front wheel rotatably secured to said base, at least one rear wheel rotatable secured to said base, and a push bar secured to said base, said rear wheel having a radius that is equal to or greater than a radius of said front wheel, said at least one front wheel and said at least one rear wheel rotating about axes positioned on said base such that a center of gravity of the welder or power supply lies on or between said axes, said axes being spaced apart along the longitudinal axis of said base so that the

Appeal No. 2004-1910
Application No. 09/411,106

spacing is less than about 3 times the sum of the radii of said front and rear wheels.

The references set forth below are relied upon by the Examiner as evidence of obviousness:

| | | |
|-----------------------------------------|-----------|-----------------------|
| Momberg | 4,062,430 | Dec. 13, 1977 |
| Karpoff et al. (Karpoff) | 5,730,891 | Mar. 24, 1998 |
| Magda | 4,926,768 | May 22, 1990 |
| Sueshige et al. (Sueshige) ¹ | 6,129,166 | Oct. 10, 2000 |
| | | (filed Oct. 24, 1997) |

On page 5 of their January 30, 2004 answer, the Examiner and her SPE present their § 112, first paragraph, rejection in the following manner:

Claims 48-61 [sic, 48-50, 52-61], 73-75 and 82 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In Claim 48, line 5 recites, as amended, "...said at least one front wheel and said at least one rear wheel rotating about axes positioned on said base..." (emphasis added). The claim before amendment was drawn to axles of said front and rear wheels positioned on said base. The change from claimed axles to axes constitutes new matter. There is not support in the specification for this change. In addition, the claim is an apparatus claim and while a claimed axle has a physical structure, which further limits the apparatus,

¹ In their various answers, the Examiner and her SPE have incorrectly referred to this reference as "Sueshinge."

Appeal No. 2004-1910
Application No. 09/411,106

an axis is simply an imaginary line and not a physical structure. Likewise, new independent claim 74 claims in lines 4-6, "...said at least one front wheel and said at least one rear wheel rotating about axes positioned on said base..." In addition, claim 56 changes [sic] "axles" to "axes."

In addition, claims 1, 3, 5, 9, 13, 16, 22, 24, 26 and 29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Karpoff in view of Sueshige and Magda, and claim 19 is correspondingly rejected over these references and further in view of Momberg.

Finally, claims 48-50, 52, 54, 57, 61 and 74 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Karpoff in view of Magda, and claims 53, 55 and 58-60 are correspondingly rejected over these references and further in view of Sueshige.

We refer to the various briefs² and answers of record for a complete exposition of the opposing viewpoints expressed by the Appellants and by the Examiner and her SPE concerning the above noted rejections.

² On page 5 of their brief (filed May 1, 2002) and elsewhere, the Appellants "request that the Board enter the Proposed Amendment For Appeal of Exhibit A for purposes of the present Appeal." We will not consider this request since it relates to a petitionable, rather than an appealable, matter. See the Manual of Patent Examining Procedure (MPEP) § 1201 (August 2001) in comparison with § 1002.02(c) (Rev. 2, May 2004). Also see In re Mindick, 371 F.2d 892, 152 USPQ 566 (CCPA 1967).

Appeal No. 2004-1910
Application No. 09/411,106

OPINION

We cannot sustain any of the above noted rejections.

In order to comply with the written description requirement set forth in the first paragraph of 35 U.S.C. § 112, an applicant's original disclosure must convey with reasonable clarity to those skilled in the art that the applicant, as of the filing date sought, was in possession of the claimed invention. See Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-1564, 19 USPQ2d 1111, 1116-1117 (Fed. Cir. 1991).

When this test for compliance with the written description requirement is applied to the facts of this appeal, it is clear that there is utterly no merit in the position of the Examiner and her SPE that the term "axes," which is recited in claims 48, 56 and 74, "constitutes new matter" (January 30, 2004 answer, page 5). As correctly explained by the Appellants, descriptive support for this term is explicitly provided by their original disclosure in lines 14-16 on specification page 16 and in original claim 32. The Examiner's and her SPE's refusal, on page 12 of the January 30, 2004 answer, to accept this explanation lacks perceptible rationale and completely ignores (and indeed is contrary to) the aforementioned disclosure in original claim 32. Even disregarding this explicit descriptive support, the original disclosure of this

Appeal No. 2004-1910
Application No. 09/411,106

application would convey to an artisan with reasonable clarity that the Appellants, on their application filing date, were in possession of a moveable undercarriage having the here claimed "axes" feature for the reasons well and thoroughly stated by the Appellants in their various briefs. We share with the Appellants a complete inability to appreciate any logical basis for the Examiner's and her SPE's opposing view.³

In light of the foregoing, it is apparent that we cannot sustain the § 112, first paragraph, rejection advanced by the Examiner and her SPE of claims 48-50, 52-61, 73-75 and 82.

Concerning each of their § 103 rejections, the Examiner and her SPE urge that Figure 1 of Karpoff shows that "the rear axle and front casters [of patentee's undercarriage] are spaced at less than about three times the sum of the radii of the front and rear wheels" (January 30, 2004 answer, page 6; also see page 9 of this answer). This contention relates to the requirement in appealed independent claims 1 and 48 for a corresponding spacing which is "less than about 3 times the sum of the radii of said front and

³ The previously quoted statement by the Examiner and her SPE that "an axis is simply an imaginary line and not a physical structure" (January 30, 2004 answer, page 5) strikes us as particularly irrational and irrelevant with respect to the written description issue under consideration.

Appeal No. 2004-1910
Application No. 09/411,106

rear wheels" and the requirement in appealed independent claim 74 for a spacing which is "less than about 2 times the sum of the radii of said front and rear wheels." For at least two reasons, it is quite clear that we cannot accept this contention by the Examiner and her SPE.

First, as properly noted by the Appellants, Karpoff does not disclose that his Figure 1 drawing is to scale and therefore no basis exists for the position taken by the Examiner and her SPE that this figure shows the here claimed spacing feature. See, for example, the Appellants' more detailed exposition on pages 20 and 21 of their May 1, 2002 brief including the authority citations contained therein.

Second, as again properly noted by the Appellants, even if Figure 1 of Karpoff were assumed to be drawn to scale, the measured distance between the rear axle and the front spindle would be 70.75mm and thus greater than 67.5mm which is three times the sum of the measured radii of the front and rear wheels; see page 23 of the brief. In response to the Appellants' last mentioned argument, the Examiner and her SPE make the incredible statement that "the [aforementioned] measurements do meet the broad limitation of 'less than about three times' the sum of the radii" (January 30, 2004 answer, pages 13-14).

Appeal No. 2004-1910
Application No. 09/411,106

We can only respond to this incredible statement by explaining that a 70.75mm spacing is greater than, not less than, 67.5mm (which is three times the sum of the measured radii of Karpoff's front and rear wheels). This statement by the Examiner and her SPE is even more incredible with respect to appealed independent claim 74 since this claim requires a spacing which is "less than about 2 times the sum of the radii of said front and rear wheels."

For the reasons set forth above and in the Appellants' briefs, it is indisputable that no basis exists for the finding made by the Examiner and her SPE that Figure 1 of Karpoff shows the spacing feature recited in the appealed independent claims. We recognize that the Examiner and her SPE have made similar findings regarding the secondary references to Sueshige and Magda (e.g., see pages 6 and 7 of the January 30, 2004 answer). Although these last mentioned findings are suspect for reasons analogous to those previously discussed, we will not assess or further discuss this matter since the Examiner and her SPE have not proposed that these suspect findings would have somehow made it obvious to provide the Karpoff undercarriage with the spacing feature under consideration. Stated otherwise, the aforementioned Sueshige and Magda findings are simply irrelevant to the issues advanced on this appeal.

Appeal No. 2004-1910
Application No. 09/411,106

FAY, SARPE, FAGAN, MINNICH & MCKEE, LLP
1100 SUPERIOR AVENUE, SEVENT FLOOR
CLEVELAND, OH 44114-2518